

2,039,410 issued to Harris ("Harris reference").

The Examiner further rejected Claim 7 under 35 U.S.C. 103(a) as being unpatentable over the Harris reference in view of US Patent number 6,640,350 issued to Deutsch ("Deutsch reference"). Finally, Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Harris reference in view of US Patent number 4,155,474 issued to Bizzarri ("Bizzarri reference").

II. Applicant's Response

A. Restriction Requirement

In compliance with the Examiner's refusal to examine method Claims 13 and 14 as being directed to the non-elected invention, Applicant cancels Claim 14 and withdraws Claim 13. However, in order to retain the right to rejoinder under MPEP 821.04(b), Claim 13 has been accordingly amended.

Following MPEP 821.04(b), where restriction was required between a product and a process of making and/or using the product, and the product invention was elected and subsequently found allowable, the withdrawn process claims are eligible for rejoinder if all withdrawn process claims depend from or otherwise require all the limitations of an allowable product claim. Since Applicant believes that the method Claim 13 requires, as amended, all the limitations of the amended product Claim 1, Applicant respectfully submits that the withdrawn method Claim 13 will be eligible for rejoinder if the amended product Claim 1 is subsequently found allowable.

B. Abstract

Applicant amended the abstract to remove the phrases objected to as shown in the

marked-up copy of the abstract. Applicant respectfully submits that such amendments overcome the stated objection.

C. Missing Description for Figure 6

Applicant has amended the "Brief Description of the Drawings" section in the specification to include the brief description of Figure 6 as shown in the marked-up amendment to the specification. Applicant respectfully submits that such amendment overcomes the stated objection.

D. Amended Independent Claims 1, Original Independent Claim 3, and Original Dependent Claims 2, 4, and 5 Are Not Anticipated by the Hsieh Reference

Applicant respectfully submits that the Hsieh reference fails to disclose a 'slidable member' as disclosed in amended Independent Claims 1 and Independent Claim 3. The Hsieh reference discloses a writing instrument with a two-piece clip comprising a ferrule, a clip member, and optionally an ornamental or advertising article to be attached to the ferrule and clip.

The clip member in the Hsieh reference is U-shaped, which necessarily involves a section comprising two parallel rails, and thus discloses one element of the clip in Claims 1 and 3. But the article in the Hsieh reference is distinguished from the 'slidable member' in Claims 1 and 3 in two critical respects. First, as opposed to the Examiner's statement, the article in the Hsieh reference is not slid onto the rails during the assembly. In contrast with the member in Claims 1 and 3 that is required to be slidingly articulated onto the two parallel rails, the article in the Hsieh reference is merely inserted from the open end side of the clip member and stays fixed thereon, being blocked from sliding on the rails by the ferrule. The specification in the Hsieh reference clearly states that the article 30 is inserted into, rather than slid onto, the two free ends at the open

side of the clip member through two or one insertion hole(s) at a backside of the article, whereby the two open ends of the clip are inserted into, and partly extended from, the two small hollow cylinders of the ferrule so that they can be inserted further into the insertion hole(s) of the article. (See column 3: 15-29).

Secondly, in order for the Hsieh reference to anticipate Claims 1 and 3, it is not enough for the article to be just slidingly attached on the rails during assembly stage, but the article has to remain 'slidable' after the assembly is finished. Although the Examiner referred to the article as a 'slidable member 30', the article in the Hsieh reference, as understood by Applicant, cannot be slidable at all. As seen from the assembly procedure shown above, it is structurally impossible for the article in the Hsieh reference to slide onto the rails of the clip member because the article is physically blocked by the ferrule from the rest part of the rail after it has been inserted onto the free end of the clip member through the insertion hole(s). This structural feature can also be seen in the Figure 1-5 in the Hsieh reference. The Hsieh reference, as understood by Applicant, does not teach any 'slidability' of the article, or disclose another structure that could enable the article to slide.

The clip in the Hsieh reference is further distinguishable from the clip in the Independent Claim 3 in that the free end of the rails in the Hsieh reference is not connected with the body of writing instrument as required by the Claim 3, but instead connected to the ferrule, and further to the article, as seen above. In other words, the clip in the Hsieh reference is connected to the body of the writing instrument only indirectly through the ferrule, which cannot be considered, as understood by Applicant, either part of the body of the writing instrument, or the clip member. Therefore, the Hsieh reference is believed to be further distinguishable from Independent Claim 3 in the way the structural features are put together.

Anticipation requires that each and every element of the claimed invention be disclosed in the prior art reference. *Akzo N.V. v. United States Int'l Trade Comm'n*, 1 USPQ 1241, 1245 (Fed. Cir. 1987). The prior art must be enabling, thus placing the allegedly disclosed matter in the possession of the public. *Id.* Although drawings and pictures can anticipate claims if they clearly show the structure which is claimed, *In re Mraz*, 455 F.2d 1069; MPEP 2125, the picture must show all the claimed structural features and how they are put together. *Jockmus v. Leviton*, 28 F.2d 812 (2d Cir. 1928); MPEP 2125. As shown above, the Hsieh reference fails to disclose two critical features of amended Independent Claims 1 and 3, that is, the slidability of the member and the required way it is put together with the clip, i.e., sliding attachment. Therefore, Applicant respectfully submits that amended Independent Claim 1 and Independent Claim 3 are distinguishable from the Hsieh reference.

Dependent Claims 2,4, and 5 are also believed to be distinguishable from the Hsieh reference to the same extent that the Independent Claims 1 and 3 are.

E. Amended Independent Claim 1, Original Independent Claim 3, and Original Dependent Claims 2, 5, 6, 8, and 9 Are Not Anticipated by the Harris Reference

The Harris reference discloses a writing instrument with a clip attached thereto and an 'emblem' mounted on the clip. Applicant respectfully submits that the Harris reference fails to disclose a track comprising 'two parallel rails' or that the emblem is slidingly attached to the rails as disclosed in Independent Claims 1 and 3.

One of the clips disclosed in the Harris reference has a 'slit' on it. And the Examiner characterized the 'slit' as forming 'two parallel rails 15'. Even if the two side strips created by the 'slit' in the middle of the clip might be arguably called 'rails', Applicant respectfully submits

that they cannot be parallel to each other considering the purpose and structure of the 'slit' disclosed in the Harris reference. The specification of the Harris reference clearly states that the purpose of carving the 'slit' on its clip was to hold an emblem securely in position at the upper end of the 'slit'. (See column 2: 19-20 and Figure 1). To serve this purpose, the 'slit' has been made to widen towards the bottom, and further have a hole at the top separated from the slit by a neck. (See column 2: 16-18). This inequality of the slit's width explains why the emblem is designed to carry two prongs, and must be forced upward by pressing down the two prongs, rather than slid upward, to securely hold it in position inside the hole at the top of the slit with the aid of the springing-out force of the two prongs. (See column 2: 20-25). The Figure 1 and 5 in the Harris reference also show the non-parallel feature of the strips or 'rails' of the clip. As understood by Applicant, this non-parallel feature is structurally and functionally required according to the disclosure of the Harris reference.

Again, anticipation requires that each and every element of the claimed invention be disclosed in the prior art reference. *Akzo N.V. v. United States Int'l Trade Comm'n*, 1 USPQ 1241, 1245 (Fed. Cir. 1987). The claim language in the amended Claims 1 and 3 unambiguously requires the rails of the clip to be parallel, and that the member be slidingly attached to the rails. Therefore, Applicant respectfully submits that the Harris reference fails to disclose the aforementioned feature and in this respect, is believed to be distinguishable from the amended Independent Claims 1 and its dependent Claim 2, and Independent Claim 3 and its dependent Claims 5, 6, 8, and 9.

There is another ground on which dependent Claim 6, and its dependent Claims 8 and 9 are believed to be distinguishable from the Harris reference. The dependent Claim 6 further defines the 'sliding member' in Independent Claim 3 to comprise three segments, an inner,

middle and outer segments. However, the emblem in the Harris reference has only two parts, the body of the emblem and two prongs attached below, as clearly seen in the specification and the Figure 2 and 9. Even admitting arguably the two prongs **19** may be called an inner segment as the Examiner viewed, the middle segment is still missing in the emblem of the Harris reference.

Each of three segments in the slidable member in Claim 6 is, however, not without purpose or function. The claim language clearly demonstrates that the middle segment is needed to engage the two parallel rails of the clip. The outer and inner segments are also needed for secure engagement such that the member remains on the track without slipping while it slides between two ends of rail track, as shown in the Figure 5 in the application. For that purpose, the diameter of the middle segment has been explicitly limited to be smaller than those of the inner and outer segment in Claim 6.

By contrast in the Harris reference, the middle segment is not merely ‘not shown’ in the Figures as the Examiner stated, but is simply not there. As understood by Applicant, there was no structural or functional need to introduce the middle segment for the emblem in the Harris reference in the first place because the emblem was not intended to be freely slidable along the tracks of the clip like the slidable member in the present invention, but intended to be merely attachable to and detachable from the clip, if necessary, with the aid of two prongs and slit, and otherwise remain fixed in the hole. And to implement such intention, the disclosed structure of the emblem alone, without the middle segment, suffices.

As discussed above, the Harris reference lacks another major structural feature disclosed in the Claim 6, and on this ground too, Applicant respectfully submits that dependent Claim 6, and its dependent Claims 8 and 9 are distinguishable from the Harris reference.

F. Amended Dependent Claim 7 Is Not Obvious over the Harris Reference in

view of the Deutsch Reference.

Dependent Claim 7 has been amended to provide further consistency and clarity to the claims. First of all, Applicant respectfully submits that in the respect that dependent Claim 6, which Claim 7 is dependent from, is believed to be distinguishable from the Harris reference on two separate grounds as discussed in the previous section E, dependent Claim 7 as well is believed to be distinguishable.

Secondly, even assuming *arguendo* that the Claim 6 is indistinguishable from the Harris reference, Applicant respectfully argues that Dependent Claim 7 is still not obvious over the Harris reference in view of the Deutsch reference.

It is well settled that to modify references, there must be some suggestion to do so, even for simple changes or combinations. See In re Chu, 66 F.3d 292, 36 USPQ2d 1089 (Fed. Cir. 1995) (“Although a prior art device could have been turned upside down, that did not make the modification obvious unless the prior art fairly suggested the desirability of turning the device upside down”). In re Gordon, 733 F.3d 900, 902, 221 USPQ 1125, 1227 (Fed. Cir. 1984) (“The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.”). Thus, to modify a prior art reference to render a patent obvious requires that “the prior art suggested the desirability of the modification.” In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

The only place the Harris reference teaches, if ever, about employing any indicia upon its emblem is in the Figure 1 where a single letter ‘H’ appears on the emblem. Except that, there is no teaching as to indicia anywhere in the specification. However, the prior art must be enabling, thus placing the allegedly disclosed matter in the possession of the public. *Akzo N.V. v. United States Int’l Trade Comm’n*, 1 USPQ 1241, 1245 (Fed. Cir. 1987). Applicant respectfully argues

that a single letter in the drawings unsupported by the specification could not constitute a sufficient or enabling disclosure, and thus the Harris reference does not qualify as enabling prior art for purposes of rendering amended Dependent Claim 7 obvious.

The Deutsch reference discloses a mat for a urinal with a disk, which has indicia imprinted thereon, and is protected by an optional lens. In the first place, it is questionable whether the Deutsch reference qualifies as analogous art to the Harris reference such that they may render the present invention. But even if assuming, *arguendo*, that both references are enabling and analogous art, Applicant respectfully submits that still nothing in the Harris reference discloses the desirability or benefit of covering the indicia, or just its emblem, with a transparent cover as amended Claim 7 or the Deutsch reference teaches.

For the reasons stated above, Applicant respectfully submits that amended Dependent Claim 7 should not be deemed obvious over the Harris reference in view of the Deutsch reference.

G. Dependent Claim 10 Is Not Obvious over the Harris Reference in view of the Bizzarri Reference.

The Bizzarri reference discloses a bottle-shaped liquid container having raised indicia imprinted along the body of the container.

First, and most importantly, Applicant respectfully submits that in the respect that dependent Claim 6, which Claim 10 is dependent from, is believed to be distinguishable from the Harris reference on two separate grounds as discussed in the previous section E, dependent Claim 10 as well is believed to be distinguishable.

Secondly, even assuming *arguendo* that the Claim 6 is indistinguishable from the Harris reference, Dependent Claim 10 is still not obvious over the Harris reference in view of the

Bizzarri reference. As stated before, in order to modify a prior art reference, even for simple changes or combinations, to render a patent obvious, it is required that “the prior art suggested the desirability of the modification.” In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). But, as discussed in the section F, there has been no sufficient, enabling disclosure in the Harris reference as to placing any indicia itself on the emblem. As such, there is no teaching or suggestion in the Harris reference of applying three dimensional textures or any other means upon the indicia to improve the sensory appeal to the user of the handheld instrument as dependent Claim 10 teaches.

Finally, the purpose of employing embossed mark or inscription along the bottle lobe in the Bizzarri reference was not enhancing sensory appeal or aesthetics of the indicia, which on the other hand has been declared as the very purpose of employing three dimensional textures in Claim 10. Rather, the specification of the Bizzarri reference clearly states several times that the purpose was “to convey information concerning the containers and to give a better grip for handling.” (See column 1:57-61. See also column 2:21-22 and column 2:33-35). Although the Bizzarri reference briefly mentions aesthetic qualities for choosing “proposed form of container,” as the Examiner cited,(column 3:3-10), Applicant respectfully submits that the context of the cited paragraph makes it clear that aesthetic qualities are only by way of a bonus, and the primary purpose for the particular form of the container chosen was functional advantage. (Column 3:4-10) Furthermore, the “embossed mark or inscription” has not even been named in the list of the “proposed form of container” that has been stated to potentially have any aesthetic qualities. (See column 3:6-8).

For the reasons stated above, Applicant respectfully submits that amended Dependent Claim 10 should not be deemed obvious over the Harris reference in view of the Bizzarri

reference.

III. Conclusion

For all the reasons advanced above, Applicant respectfully submits that the application is in condition for allowance and requests that such action be taken by the Examiner.

Respectfully Submitted,

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